

3

PATENT
Attorney Docket No. 03804.0128
RPR Docket No. A2080US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:)
U.S. Patent No. 5,856,121)
Issued: January 5, 1999)
Inventors: David H. GORSKI et al.) Group Art Unit: Unassigned
Reissue Serial No.: Unassigned) Examiner: Unassigned
Filing Date of Reissue Appln.: December __, 2000)

For: GROWTH ARREST HOMEBOX GENE (AS AMENDED)

ATTN.: BOX REISSUE

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

REISSUE DECLARATION UNDER 37 C.F.R. § 1.175

We, David H. GORSKI, and Kenneth WALSH, both citizens of the United States with residences and post office addresses as listed below, do hereby state and declare as follows:

1. We believe we are the original joint inventors of the subject matter which is described and claimed in United States Patent No. 5,856,121, granted on January 5, 1999, and for which a reissue patent is sought on the invention entitled, "GROWTH ARREST HOMEBOX GENE."

2. We hereby state that we have reviewed and understand the contents of the above-identified specification, including the original patent claims, and the claims in the Preliminary Amendment filed herewith.

3. We acknowledge the duty to disclose information that is material to the examination of this reissue application in accordance with Title 37, Code of Federal Regulations, Section 1.56(a).

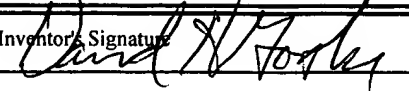

4. We believe that U.S. Patent No. 5,856,121 is at least partially inoperative or invalid by reason of our claiming more or less than we had a right to claim.

5. An error which is a statutory basis for reissue is that we failed to claim processes for expressing a Gax protein in a host cell. In addition, we failed to include a claim directed to a DNA molecule having nucleotides 749-931 of SEQ ID NO: 1.

6. The above-described error and all other errors corrected in this reissue application arose without any deceptive intent.

7. We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

DECLARATION
Reissue Application of Patent No. 5,856,121
Attorney Docket No. 3804.0128

Full Name of First Inventor David H. GORSKI	Inventor's Signature 	Date 3/22/01
Residence 25 Arrowwood Lane, Monmouth Junction, New Jersey 08852		Citizenship USA
Post Office Address Same as above		
Full Name of Second Inventor Kenneth WALSH	Inventor's Signature 	Date 01/12/01
Residence 207 Judy Farm Road, Carlisle, Massachusetts 01741		Citizenship USA
Post Office Address Same as above		
Full Name of Third Inventor	Inventor's Signature	Date
Residence		Citizenship
Post Office Address		

005070 0255460



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Assistant Commissioner for Patents
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REISSUE DECLARATION UNDER 37 C.F.R. § 1.175

We, David H. GORSKI, and Kenneth WALSH, both citizens of the United States with residences and post office addresses as listed below, do hereby state and declare as follows:

1. We believe we are the original joint inventors of the subject matter which is described and claimed in United States Patent No. 5,856,121, granted on January 5, 1999, and for which a reissue patent is sought on the invention entitled, "GROWTH ARREST HOMEBOX GENE."

2. We hereby state that we have reviewed and understand the contents of the above-identified specification, including the original patent claims, and the claims in the Preliminary Amendment filed herewith.

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, CARRETT,
& DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, DC 20005
202-408-4000

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3. We acknowledge the duty to disclose information that is material to the examination of this reissue application in accordance with Title 37, Code of Federal Regulations, Section 1.56(a).

4. We believe that U.S. Patent No. 5,856,121 is at least partially inoperative or invalid by reason of our claiming more or less than we had a right to claim.


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0975320 010501
FOI 0255260

DECLARATION
Reissue Application of Patent No. 5,856,121
Attorney Docket No. 3804.0128

Full Name of First Inventor David H. GORSKI	Inventor's Signature	Date
Residence 25 Arrowwood Lane, Monmouth Junction, New Jersey 08852		Citizenship USA
Post Office Address Same as above		
Full Name of Second Inventor Kenneth WALSH	Inventor's Signature 	Date 01/12/01
Residence 207 Judy Farm Road, Carlisle, Massachusetts 01741		Citizenship USA
Post Office Address Same as above		
Full Name of Third Inventor	Inventor's Signature	Date
Residence		Citizenship
Post Office Address		

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Reissue Application of U.S. Patent No. 5,856,121
Attorney Docket No. 03804.0128
RPR Docket No. A2080US

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In re Reissue Application of:)
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Issued: January 5, 1999)
Inventors: David H. GORSKI et al.) Group Art Unit: Unassigned
Reissue Serial No.: Unassigned) Examiner: Unassigned
Reissue Application Filed: December __, 2000)

For: GROWTH ARREST HOMEBOX GENE (AS AMENDED)

ATTN.: BOX REISSUE
Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

**CONSENT OF ASSIGNEE, OFFER TO SURRENDER
ORIGINAL PATENT, AND STATEMENT UNDER 37 C.F.R. § 3.73(b)**

U.S. Patent No. 5,856,121 is assigned to Case Western Reserve University, as assignee of the entire right, title and interest in said patent by virtue of an assignment recorded at Reel 8105, Frame 0165. Copies of these papers are attached.

Case Western Reserve University hereby consents to the accompanying application for reissue of U.S. Patent 5,856,121.

Case Western Reserve University hereby offers to surrender U.S. Patent 5,856,121, when the reissue application is otherwise in condition for allowance.

86459_1

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT,
& DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, DC 20005
202-408-4000

Reissue Application of U.S. Patent No. 5,856,121
Attorney Docket No. 03804.0128
RPR Docket No. A2080US

The undersigned, whose title is supplied below, is empowered to sign on behalf of the assignee.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date

Signature

James W. Wagner

Name

Provost & University Vice President

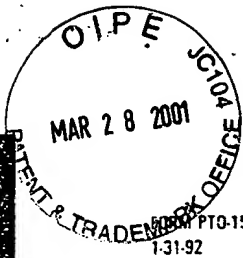
Title

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT,
& DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, DC 20005
202-408-4000

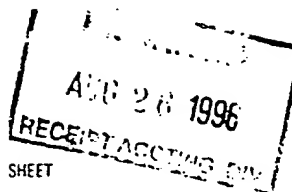
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03804.0128



08/26/96
PTO-1595
1-31-92

08-29-1996



U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

581/40

To the Honorable Commissioner of

100262108

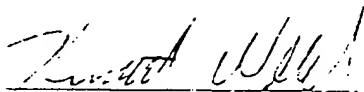
final documents or copy thereof.

<p>1. Name of conveying party(ies): David H. Gorski Kenneth Walsh</p> <p>Additional names of conveying party(ies) attached? <input type="checkbox"/> yes <input checked="" type="checkbox"/> no</p>		<p>2. Name and address of receiving party(ies): Name: <u>Case Western Reserve University</u> Internal Address: _____ Street Address: <u>10900 Euclid Avenue</u> City: <u>Cleveland</u> State: <u>Ohio</u> Zip: <u>44106</u></p> <p>Additional name(s) & address(es) attached? <input type="checkbox"/> yes <input checked="" type="checkbox"/> no</p>					
<p>3. Nature of Conveyance <input checked="" type="checkbox"/> Assignment <input type="checkbox"/> Merger <input type="checkbox"/> Security Agreement <input type="checkbox"/> Change of Name <input type="checkbox"/> Other _____</p> <p>Execution Date: <u>December 13, 1993</u></p>							
<p>4. Application number(s) or patent number(s): <u>08/203,532</u></p> <p>If this document is being filed together with a new application, the execution date of the application is _____</p> <table border="0"><tr><td>A. Patent Application No(s): <u>08/203,532</u></td><td>B. Patent No(s): _____</td></tr></table> <p>Additional numbers attached? <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No</p>				A. Patent Application No(s): <u>08/203,532</u>	B. Patent No(s): _____		
A. Patent Application No(s): <u>08/203,532</u>	B. Patent No(s): _____						
<p>5. Name and address of party to whom correspondence concerning document should be mailed: Jeanne E. Longmire Calfee, Halter & Griswold 300 Superior Avenue - Suite 1400 Cleveland, Ohio 44114-2688</p>		<p>6. Total number of applications and patents involved: <u>1</u></p> <p>7. Total fee (37 CFR 3.41): <u>\$ 40.00</u></p> <p><input checked="" type="checkbox"/> Enclosed <input checked="" type="checkbox"/> Authorized to be charged to deposit account <input type="checkbox"/> Total fee due <input checked="" type="checkbox"/> Any deficiencies in the enclosed fees</p> <p>8. Deposit account number: <u>03-0172</u></p>					
<p>DO NOT USE THIS SPACE</p>							
<p>9. Statement and signature <u>150 PM 08/29/96 100262108</u></p> <p>To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.</p> <table border="0"><tr><td><u>Jeanne E. Longmire</u> Name of Person Signing</td><td><u>[Signature]</u> Signature</td><td><u>8/23/96</u> Date</td><td>Total number of pages comprising transmittal: <u>1</u></td></tr></table>				<u>Jeanne E. Longmire</u> Name of Person Signing	<u>[Signature]</u> Signature	<u>8/23/96</u> Date	Total number of pages comprising transmittal: <u>1</u>
<u>Jeanne E. Longmire</u> Name of Person Signing	<u>[Signature]</u> Signature	<u>8/23/96</u> Date	Total number of pages comprising transmittal: <u>1</u>				

CERTIFICATE OF MAILING STAMP ON REVERSE SIDE

ASSIGNMENT

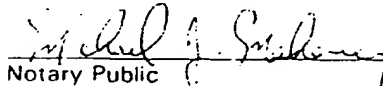
For One Dollar (\$1.00) and other good and valuable consideration received of the hereinafter named assignee, receipt of which is hereby acknowledged, we, the undersigned Kenneth Walsh of 11518 Chesterland Street, Chesterland, Ohio 44026, U.S.A.; David Henry Gorski of 12805 Shaker Blvd., #401, Cleveland, Ohio 44120, U.S.A.; hereby assign all rights, title and interest to Case Western Reserve University, having a place of business at 10900 Euclid Avenue, Cleveland, Ohio 44106, U.S.A., its successors and assigns, the entire right, title and interest, so far as concerns the United States and the Territories and Possessions thereof and all foreign countries, in and to the inventions in Growth Arrest Homeobox Gene set forth in the application for United States Letters Patent filed in the U.S. Patent and Trademark Office (serial number not yet assigned), said application for United States Letters Patent, any and all other applications for Letters Patent on said inventions in countries foreign to the United States, including all divisional, renewal, substitute, continuation and Convention applications based in whole or in part upon said inventions or upon said applications, and any and all Letters Patents and reissues and extensions of Letters Patent granted for said inventions, said applications and said Letters Patent; said assignee being hereby authorized to file patent applications in any or all countries on any or all said inventions in the name of the undersigned or in the name of said assignee or otherwise as said assignee may deem advisable, under the International Convention or otherwise; the Commissioner of Patents of the United States of America and the empowered officials of all other governments being hereby authorized to issue or transfer all said Letters Patent to said assignee in accordance herewith; this assignment being under covenant, not only that full power to make the same is had by the undersigned, but also that such assigned right is not encumbered by any grant, license, or other right heretofore given, and that the undersigned will do all acts reasonably serving to assure that the said inventions, patent applications and Letters Patent shall be held and enjoyed by said assignee as fully and entirely as the same could have been held and enjoyed by the undersigned if this assignment had not been made, and particularly to execute and deliver to said assignee all lawful documents including petitions, specifications, oaths, assignments, invention disclaimers, and lawful affidavits in form and in substance which may be requested by said assignee, to furnish said assignee with all facts relating to said inventions or the history thereof and any and all documents, photographs, models, samples or other physical exhibits which may be useful for establishing the facts of conception, disclosure and reduction to practice of said inventions; and to testify in any proceedings relating to said inventions, patent applications and Letters Patent.


Kenneth Walsh

State of Ohio)
) SS:
County of Cuyahoga)

On this 15th day of December, 1993, personally appeared before me Kenneth Walsh, to me known to be the person named in and who executed the above instrument, and acknowledged to me that he executed the same for the uses and the purposes therein mentioned.

12/15/93
Date


Notary Public

Notary Public for the State of Ohio
My Commission Expires 12/31/95

State of Ohio:

1 SS:

On this 18th day of December, 1993, personally appeared before me David Henry Gorski, to me known to be the person named in and who executed the above instrument, and acknowledged to me that he executed the same for the uses and the purposes therein mentioned.

Date 13/4/20

S. J. [Signature]
Notary Public

MICHAEL J. GIBNEY Attorney
 DISTRICT COURT - 1475 1st AVE
 My commission expires - 11/11/2016
 Court No. 1475 1st AVE, C.



PAGE: 1

PATENT NUMBER: 5856121
SERIAL NUMBER: 08/203532
TITLE: GROWTH ARREST HOMEBOX GENE
APPLICANT: GORSKI, DAVID H. ; WALSH, KENNETH

REEL: 008105 FRAME: 0165 DATE RECORDED: 08/26/96 NUMBER OF PAGES: 003
ASSIGNOR: GORSKI, DAVID H.

EXC DATE: 12/13/93
WALSH, KENNETH

EXC DATE: 12/13/93
ASSIGNEE: CASE WESTERN RESERVE UNIVERSITY
10900 EUCLID AVENUE
CLEVELAND, OHIO 44106

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

PRESS XMIT FOR NEXT PAGE OR FOR A SPECIFIC PAGE
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10/18/99 14:56

PAGE: 2

RETURN ADDRESS: CALFEE, HALTER & GRISWOLD
JEANNE E. LONGMUIR
800 SUPERIOR AVENUE, STE. 1400
CLEVELAND, OH 44114-2688

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